

REMARKS

Paragraphs 1 and 2 of the Office Action

Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S.

5 Patent 5,708,412 to Proulx.

Applicant's device allows for the measuring of the temperature of an engine adjacent to the engine to measure the ambient temperature of the air around the engine. This allows for an accurate reading without reliance on a temperature gauge that is abutted against the engine itself or is in contact with the coolant of the engine.

10 It is respectfully submitted that Proulx does not suggest that type of system.

Proulx states, in multiple instances, that the temperature gauges are either integral with the engine or the coolant, or are abutted against the engine to take a direct reading of the engine. This can lead to an inaccurate reading if there is a coolant leak and can also lead to gauge failure as it is subjected to the direct heat of the engine. Since both the structure
15 and the use of the device differ, there cannot exist a proper 103 obviousness argument and therefore it is believed that claims 1 and 6, and all claims depending from claim 1, are in condition for allowance.

With respect to claim 5, the magnet is used because, unlike Proulx, the magnet does not require extension into the engine itself and the magnet spaces the heat sensor
20 from the engine. As mentioned above, this allows for an ambient temperature reading and not a direct reading of the engine temperature. Further, unlike Proulx, applicant's device is easily retrofitted to existing engines because no drilling into the engine is required. Not only is drilling not required, no mountings are required at that need threaded fasteners or other additional parts that can fail over time. That the Examiner
25 states that the modification to a magnet is an obvious design choice is not accurate. First, there is nothing within the prior art to suggest that a magnet be used in this manner. For that reason, there can be no motivation to use magnet over the fasteners discussed in Proulx. The law is clear that the mere capability of one skilled in the art to make a combination does not necessarily motivate one skilled in the art to make the combination-
30 -there must be a motivation provided by the prior art.

5 The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

10 The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

15 Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original). Second, since the Examiner has simply stated that the choice is an obvious one of design, the Examiner is asked to either supply such a reference or allow the claim since the use of the magnet provides a function and a structure that were not contemplated in the prior art and the abovementioned function serves a previously unknown need. Therefore, the choice was not obvious, and could not be since the issue was not raised before, and claim 5 is believed to be in condition for allowance.

 The applicant respectfully requests withdrawal of the rejection.

CONCLUSION

5

In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

10



Date: 9/24/05

Sean A. Kaufhold (Reg. No. 46,820)

P.O. Box 89626

15 Sioux Falls, SD 57109

(605) 334-1571 FAX (605) 334-1574